UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,532	06/11/2001	Michael A. Inchalik	82810RLO	4221

7590 03/27/2006

Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER	
OYEBISI, OJO O	
ART UNIT	**PAPER NUMBER**
3628	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/878,532	INCHALIK ET AL.	
	Examiner	Art Unit	
	OJO O. OYEBISI	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al (U.S. 6,298,441) in view of RFC 2104 ("CHMAC: Keyed-Hashing for Message Authentication"), Yamagishi (U.S. 5,379,433), and Richards (U.S. 6,385,723).

Re claims 1, 2. Hadelman et al disclose a method of transferring information from a content supplier from one or more databases, such information including program(s), audio, still, data files, or video (i.e., lists, spreadsheets, reports, documents, presentation graphics, sales information) or combinations thereof to a remote location (see col.3, lines 9-19) that uses an authorizing hybrid optical disc that permits the use of such transferred information, comprising the steps of: (a) providing an authorizing hybrid optical disc having a ROM portion and a RAM portion (see col.9, lines 21-27 and col.12, lines 36-54); (b) providing the ROM portion to include a preformed identification signature which is impressed into the ROM portion of the disc and is arranged to be difficult for a pirate to copy (see col.4, lines 11-21); (e) downloading the selected information to the user's memory location for use by the user (col 4, lines 22-25). The examiner has interpreted the term "disc" to also include cards. This may include smart

cards or integrated circuit cards. It should be noted that the smart card device as disclosed by Handelman et al can make use of a separate memory card which can also be an optical disc (see col. 9, lines 21-27). Further, Handelman et al later disclose that the memory card and the smart card can be combined into one card/disc (see col. 12, lines 3740). In column 4, lines 11-21, Handelman disclosed that a user of a smart card would not be able to receive a document unless they were authorized to do so. Such authorization can only come about through the use of some sort of identification feature encoded within the smart card. The examiner has interpreted any such identification feature as a signature, including passcodes, keys, message authentication codes, or passwords. Further, Yamagishi also discloses the use of hybrid optical discs, which include a RAM and an identification signature located in a ROM portion and is arranged to be difficult for a pirate to copy (col 2, lines 23-56). One of ordinary skill in the art at the time of the applicant's invention would be motivated to make use of a hybrid optical disc as a smart card because the amount of memory that is available on an optical disc to use as storage for downloaded information is often much greater than other types of memory cards for the same amount of space taken up. Handelman et al does not disclose providing the RAM portion which includes user-specific encrypted information which makes the authorizing device unique for a specific user and in combination with the ROM preformed identification signature, provides a user-personalized secure signature. However, RFC 2104 discloses a mechanism for message authentication using a cryptographic hash function and a secret key (Abstract). Further, RFC 2104 states that the keys should be randomly chosen and refreshed or exchanged

periodically (section 3). The nature of an optical disc is such that only the RAM portion of the disc can be written and rewritten by a user, so the key can only be stored in the RAM portion of the disc since the key needs to be exchanged periodically. It also makes sense to encrypt the key for security reasons. The key, along with the identification signature already disclosed to exist in the ROM portion of the hybrid disc, would allow for creating a user-personalized secure signature in accordance with the teachings of RFC 2104. One of ordinary skill in the art at the time of the applicant's invention would be motivated to do so because it would allow for the creation of a more secure signature and in case one signature is compromised, a new one can be created easily by the user choosing a new key. Handelman does not disclose a content supplier authenticating a user using the user-personalized secure signature so as to permit a user to communicate over a network with the content supplier and the user selecting information desired to be downloaded. However, Richards discloses a communication scheme in which a person would encrypt a message using the key of the person who will be receiving the message before sending the message (see col 5, lines 23-33). One of ordinary skill in the art would be motivated to combine the teachings of Handelman et al and Richards so that the information downloaded to the user's memory location by the content supplier is first encrypted before being sent because Handelman et al were interested in securing documents so that only authorized users would have access and encrypting such documents before sending them would further secure the documents.

Re claim 3. Hadelman et al further disclose the method of claim 1 wherein a channel is used to communicate with the remote location via a network and wherein the hybrid disc is encoded with the address of the remote location (see col.2, last paragraph; col.3 1st paragraph, and col.4, lines 26-31).

3. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al (U.S. 6,298,441) in view of RFC 2104 ("CHMAC: Keyed-Hashing for Message Authentication"), Yamagishi(U.S. 5,379,433), Richards (U.S. 6,385,723), and Wyatt (U.S. 6,041,411).

Re claim 4. None of Haldelman et al, RFC 2104, Yamagishi, and Richards explicitly disclose the method of claim 3 wherein the channel is the Internet. However, Wyatt discloses the use of the internet as the channel for communication. Thus, one of ordinary skill in the art would have been motivated to use the Internet as the communication channel because it would allow the content providers in Handelman et al's invention to reach a larger population of user more easily and to generate more profit.

Re claim 5. None of Haldelman et al, RFC 2104, Yamagishi, and Richards explicitly disclose the method of claim 1 wherein the user-personalized secure signature includes payment authorizing information. However, Wyatt discloses that in one embodiment of his invention, payment information only needs to be entered once and such things as account or credit card number will be stored and associated with the secure signature of the user (col 5, last paragraph). In this manner, the payment authorizing information is the user-personalized secure signature. Thus, one of ordinary skill in the art at the time

of the applicant's invention would have been motivated to combine Wyatt, Haldelman et al, RFC 2104, Yamagishi, and Richards teachings as it would allow for faster transactions to occur without the user having to enter payment information for each transaction. As such, a content provider would be able to utilize less network resources for each transaction and save on the overhead costs of selling digital content.

Re claim 6. None of Haldelman et al, RFC 2104, Yamagishi, and Richards explicitly disclose a method of claim 1 further including the step of a user making payment via the network for the transfer of the selected information. However, Wyatt discloses an ecommerce system in which payment is made via a network for the selected information (col 6, lines 26-55). Thus, one of ordinary skill in the art at the time of the applicant's invention would have been motivated to combine Wyatt, Haldelman et al, RFC 2104, Yamagishi, and Richards teachings because many content providers would naturally want to be paid for their contents and Handelman et al disclosed that the content would only be downloaded if the price of the content is within the user's spending limit (see col.3 2nd paragraph). A payment via a network would be the fastest and most convenient way of rendering payment to the content provider. Further, payment via a credit card over a network has been known at the time of the applicant's invention.

Re claim 7. None of Haldelman et al, RFC 2104, Yamagishi, and Richards disclose a method of claim 6 wherein payment is provided by a user by transferring a payment number which can be used for transferring a predetermined payment amount from a commercial institution that can be for a number of content selections to be selected by the holder of the hybrid optical disc. However, Wyatt discloses entering an account

number and a credit card number into an order form so that payment could be rendered for the content selected by a user (col 5, lines 52-56). Thus, one of ordinary skill in the art at the time of the applicant's invention would have been motivated to combine Wyatt, Haldelman et al, RFC 2104, Yamagishi, and Richards teachings for user's identity verification.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Davis et al (U.S. 6,105,008) discloses using a smart card to pay for goods and services.

2. Spies et al (U.S. 6,055,314) discloses a smart card with RAM and ROM portion and use of the public and private key to encrypt and decrypt data.

3. Akiyama et al (U.S. 5,805,699) discloses a method of copying CD's with the use of signatures.

4. Downs et al (U.S. 6,226,618) discloses accessing secure content controlled by a vendor via a network and using a key or signature.

5. Kyer et al (U.S. 5,671,276) discloses encrypting and decrypting packages of services on a network.

6. Mochizuki (U.S. 6,097,814) discloses an optical disk with cipher key.

7. Morales (U.S. 5,291,554) discloses electronic distribution of content over a network and payment system.

8. Tolopka et al (U.S. 6,044,349) discloses a smart card with encrypted

identifying data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***

HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600